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REMARKS

Claims 1-17 are pending in the present application. Claims 10, 13 and 16 are withdrawn from consideration. Claims 1-9, 11, 12, 14, 15, and 17 are rejected.

The Examiner has made the present application subject to restriction under 35 U.S.C. 121 as follows:

- I: Claims 1-9, 11, 12, 14, 15 and 17, drawn to a composition comprising the reaction product of a polyepoxide, dimer fatty acid and polyisocyanate combined with an amino functional silane and a substrate coated therewith;
- II: Claims 10 and 13, drawn to the composition of Invention I further comprising additional amino functional compound(s); and
- III: Claim 16, drawn to a coated substrate comprising a base coat and a top coat.

Applicants elected with traverse to have Invention I (as defined by the Examiner) claims elected. Applicants affirm this election, but without traverse.

In response to the Examiner's requirement that Applicants elect a single disclosed species within each of items:

- (a) polyepoxides;
- (b) aminosilanes
- (c) compositions with or without the pigment of claim 12, wherein if its presence is elected a particular species thereof is identified; and
- (d) contingent upon election of Group II (or Invention II), items a, b, c hereinabove and the additional amino functional compounds),

Applicants elect (a) for polyepoxide: Epon 828, as described on page 4, lines 10-12; (b) for aminosilane: N-beta(aminoethyl)gamma-aminopropyltrimethoxysilane (commercially sold as Silquest® A 1120), as described on page 6, lines 26-27, and (c) for c: wherein the pigment of claim 12 is not present. As Group II has not been elected for examination, election of an additional amino functional compound is not required.

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Applicants agree to the withdrawal pursuant to 37 C.F.R. §1.142(b) of claims 10, 13 and 16 that do not read upon the elected species, subject to rejoinder upon allowance of one or more of the generic claims (M.P.E.P. 821.04 et seq).

Claims 1-9, 11, 12, 14, 15, and 17 are pending and have been rejected under 35 U.S.C. 103(a) as being unpatentable over Merton et al., US Pat. No. 4,430,479 in view of Stalego US Pat. No. 3,562,081; Adaniya et al., US Pat. No. 4,775, 600 and Kordomenos et al US Pat. No. 4,486,556.

Applicants are not certain whether the Examiner has based the 103(a) rejection on a combination of all the cited references, or whether the rejection is based on the primary Merton reference, in view of each of the secondary references separately. In any event, in an attempt to advance prosecution of the present application, Applicants request that the Examiner consider this reply as a bona fide attempt to be responsive to the Office Action.

The Examiner has rejected claims 1-9, 11, 12, 14, 15 and 17 under 35 U.S.C. 103(a) as being unpatentable over Merton et al. in view of Stalego. Applicants traverse the rejection. Merton et al. discloses an adhesive comprising an organic polymer having crosslinkable functional groups obtained by the sequential reaction of a diepoxide, a dicarboxylic acid, and finally a polyisocyanate. In the reaction of the diepoxide and the dicarboxylic acid to form a polyester intermediate, Merton, at col. 4 lines 49 through col. 5, line 11 incorporates by reference Jones et al., US Pat. No. 3,639,655 for preparing this compound. Turning to Jones et al., it is seen that the polyester is produced by the reaction of a diepoxide with a diacid in a mole ratio of from 0.95:1 to 1.05:1. (See Jones et al column 3 lines 5-8).

In contrast, Applicants teach, at page 3 lines 11-13, the use of an diepoxide:dimer acid ratio of greater than 1.3:1. Consequently, Applicants' intermediate compound has more available epoxy groups than Merton. Further, Merton then reacts the (hydroxy functional) polyester with a polyisocyanate. The mole ratio of NCO:OH in Merton is from 0.5:1 to about 4:1. (Merton col. 5, lines 28-30). In contrast, Applicants' NCO:OH mole ratio is 0.15:1 to 0.3:1 (see page 3 lines 20-21 of the present specification). Merton produces not only a different polyester intermediate, but then Merton also uses a different NCO:OH mole ratio to produce a different final product.

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The reliance of Merton et al. on Jones et al. to limit the diepoxide:dimer acid molar ratio teaches away from the claimed molar limits that are recited in claim 1. In view of Merton, claim 1 is now amended to distinguish over Merton. Accordingly, reconsideration of the rejection is requested.

Further, Stalego is directed to a binder composition, prepared from aqueous emulsion that is the reaction product of an epoxy resin, a dimer acid, a curing agent for the epoxy resin, a silane bonding aid, and a solvent. Each of the components of Stalego are combined at once. See Stalego col. 2 lines 28-50, and col. 8, lines 25-27. Even then, Stalego produces a binder composition, which is but one of the components in Applicants' claimed coating composition. Consequently, Stalego fails to teach each and every element of Applicants' claimed coating composition.

Further Stalego discloses a binder composition wherein the curing agents are polyamines or other polyamides. Accordingly, it is clear from Stalego that the curing agent is available to react directly with the epoxide (see col. 3 lines 50-54 and col. 7 lines 25-42). Contrastly, Applicants' invention requires the presence of polyisocyanate to react with polyepoxy resin. Stalego fails to disclose the presence of isocyanate, and therefore, does not and can not result in Applicants' binder component, nor in Applicant's coating composition. Consequently, the failure of Merton et al to disclose each and every element of Applicants' claimed invention is not cured by Stalego. Accordingly, the rejection based on Merton in view of Stalego is traversed and reconsideration of the rejection is requested.

The Examiner has also applied Adaniya as a basis for rejecting Applicants' claims 1-9, 11, 12, 14 and 15 under 35 U.S.C. (103)a in combination with Merton et al. as the primary reference (and possibly further, in combination with Stalego, and Kordomenos). The Examiner remarks that Adaniya discloses epoxy resin with a fatty acid.

Adaniya et al. discloses modification of epoxy resins with monocarboxylic acids (see col. 5 lines 36-44). Applicants' invention differs from the disclosure of Adaniya et al. in that it teaches modification of the epoxy resin with dimer fatty acids. On this basis, a rejection under 35 U.S.C. 103(a) can not be sustained. Furthermore, Adaniya et al on col. 5 lines 52-59, state that when a dicarboxylic acid can be used, it is not suitable for obtaining a film because the molecular weight of the epoxy is increased beyond a necessary level, and control of the reaction for obtaining [sic] a

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certain molecular weight distribution is difficult and no improvement of the corrosion resistance can be observed. Adaniya et al. clearly teaches away from the use of dicarboxylic acids to make a suitable film. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

The Examiner also cites Kordomenos et al. as a basis to reject Applicants' claims under 35 U.S.C. 103(a), in combination with Merton et al. Applicants traverse the rejection. Kordomenos is directed to thermosetting coating composition. However, Kordomenos does not disclose a composition that comprises an amino functional silane, as is required by Applicants' claim 1, and claims 2-9, 11, 12, 14, 15 and 17, which depend from claim 1. The Examiner has admitted that Merton fails to disclose the amino functional silane. Consequently, the combination of Merton with Kordomenos does not disclose each and every element of Applicants' claimed invention. Accordingly, a prima facie case of obviousness has not been made. Withdrawal of the rejection is proper.

Finally, a combination of Merton et al. with Stalego Adaniya et al. and Kordomenos does not arrive at Applicants' invention. In combination the cited references fail to teach Applicants' claimed coating composition, comprised of a modified epoxy resin that is the reaction product of a polyepoxy resin with a dimmer fatty acid, having the molar ratio of Applicants' invention, and further comprising a polyisocyanate. Accordingly, withdrawal of the rejections made under 35 U.S.C. 103(a) is proper.

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In view of the foregoing, allowance of the above-referenced application is respectfully requested.

Respectfully submitted,



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